

REMARKS

I. Introduction

Claims 1-71 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Brenner et al. U.S. Patent No. 6,099,409 (hereinafter "Brenner") in view of LaDue U.S. Patent No. 5,999,808 (hereinafter "LaDue") and further in view of Uranaka et al. U.S. Patent No. 6,421,536 (hereinafter "Uranaka"). Applicants respectfully traverse the 35 U.S.C. § 103(a) rejection.

II. Applicants' Reply to the Office Action

Applicants' independent claims 1, 32, 35, 36, 37, 40 and 41 are generally directed toward interactive wagering on races with a cellular telephone. Racing data on races that have not been run and that a user is allowed to place wagers on are received at the cellular telephone. A user is allowed to select to present the racing data in audio form or visual form, and the racing data is presented on the cellular telephone based on the user selection.

The Examiner admits that neither Brenner nor LaDue teaches "the ability to select to present the racing data in audio form or visual form." (Office Action, page 3). However, the Examiner opines that Uranaka shows a cellular telephone that allows a user to "select what type of communication, audio or

visual, which it would receive." (Office Action, page 3).

Applicants respectfully disagree.

A. Uranaka Fails to Show or Suggest
Allowing a User to Select to Present
Racing Data In Audio or Visual Form

Uranaka refers to a communication system including an exchange, a base station, a cellular telephone, and a computer. The cellular telephone is in radio communication with the base station, which is connected to the exchange. The computer is also connected to the exchange and is capable of communicating directly with the cellular telephone. (See Uranaka, FIG. 1 and col. 8, lines 5-10).

Uranaka's communication system allows an incoming call to a cellular telephone to be redirected to a computer associated with the cellular telephone. This process begins with the exchange receiving an incoming call. The incoming call may be a voice call or a packet communication call. The exchange sends an incoming call notification to the cellular telephone through the base station. Upon receipt of the incoming call notification, the cellular telephone creates a call report indicating receipt of the incoming call notification. The cellular telephone then transmits the call report to a computer that is associated with the cellular telephone. Based on information automatically added to the call

report by the cellular telephone, the computer may then create a call conversion request, requesting redirection of the call from the cellular telephone to the computer. The computer then sends the redirection request to the exchange, which routes the call either to the cellular telephone or the computer. (See Uranaka, col. 9, lines 18-57).

Uranaka's communication system is capable of processing two distinct types of calls: voice calls and packet communication calls. "[W]hen a call directed to the cellular telephone is a packet communication call, a packet communication is performed between the computer and the exchange. When a call directed to the cellular telephone is a voice call, the computer merely displays information relating to the call such as a calling party number and the voice call is actually processed by the cellular telephone." (Uranaka, col. 13, lines 50-56, emphasis added). Thus, it is clear that in Uranaka's communication system voice calls are handled by the cellular telephone, while packet communication calls (i.e., data or image) are handled by the computer.

Accordingly, the combination of Brenner, LaDue, and Uranaka fails to show or suggest allowing the user to select to present the incoming racing data on the cellular telephone in audio form or visual form, as required by applicants' independent claims 1, 32, 35, 36, 37, 40 and 41. The mere

ability for a cellular telephone to receive a certain type of communication—either audio or visual—does not suggest the ability to allow a user to select to present a communication in one of these forms.

Moreover, since the combination of Brenner, LaDue, and Uranaka fails to show the user selection to present racing data in audio or video form, the combination consequently also fails to show or suggest the presentation of the racing data on the cellular telephone based on the user selection, as also required by each of applicants' independent claims. For instance, if the user selects to present the racing data in visual form, applicants' claimed invention presents the racing data visually to the user using the cellular telephone. If the user selects to present the racing data in audio form, the racing data is presented audibly to the user using the cellular telephone. The combination of Brenner, LaDue, and Uranaka does not show this functionality.

In stark contrast, the paragraph of Uranaka that the Examiner cites in the Office Action (col. 15, lines 9-16) allows a computer, not a cellular telephone, to receive a packet communication call. Information indicating whether the call is a voice call or a packet communication call is added to the call report and sent from the cellular telephone to the computer. In this way, a packet communication "can be performed between the

exchange and the computer," while voice calls are routed to the cellular telephone. (Uranaka, col. 15, lines 9-16, emphasis added).

Applicants submit that Uranaka merely shows two distinct ways to process two distinct types of information. Packet communication is received and processed by the computer, while voice communication is received and processed by the cellular telephone. The call report determines to which device the communication is directed. Therefore, a user of Uranaka's communication system is not given an opportunity to select to present data in either audio or video form on the cellular telephone, as in applicants' claimed invention.

For at least the above reasons, applicants submit that the Examiner has misconstrued Uranaka. It is well established that "to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art" (MPEP § 2143.03). *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The combination of Brenner, LaDue, and Uranaka clearly fails to disclose or suggest at least 1) the user selection of presenting racing data in audio form or visual form and 2) the presentation of the racing data on the cellular telephone based on the user selection. Accordingly, the Examiner's rejection under 35 U.S.C. § 103(a) is insufficient as a matter of law.

B. There is Insufficient Motivation
to Combine Brenner and LaDue with Uranaka

Moreover, the Office Action did not provide sufficient motivation for combining Brenner and LaDue with Uranaka. See In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998) ("When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references"). See also MPEP §§ 2142 and 2143.01. The Office Action merely contends that it would have been obvious to combine Brenner and LaDue with Uranaka "to allow the user to further select to present the data in audio or visual form." (Office Action, p. 4).

However, the motivation proffered by the Examiner is a mere reiteration of applicants' own claimed functionality. Unlike Brenner and LaDue, Uranaka is not related to the domain of interactive gaming or wagering. Rather, Uranaka's communication system is only concerned with integrating voice and packet communication between cellular telephones and computers. Therefore, one skilled in the art of interactive wagering would not look to Uranaka for guidance in receiving racing data using a cellular telephone. Without some objective evidence of a motivation to combine, the obviousness rejection is the "essence of hindsight" reconstruction, the very "syndrome" that the requirement for such evidence is designed to

combat, and insufficient as a matter of law. In re Dembiczak, 50 U.S.P.Q.2d 1614, 1617-1618 (Fed. Cir. 1999).

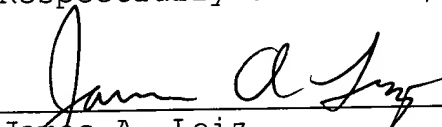
Applicants submit that the only suggestion or motivation for the combination of Brenner and LaDue with Uranaka is provided by the teachings of applicants' own disclosure. Without a proper motivation for combining the references, the Office Action has "simply take[n] the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability," a practice that is insufficient as a matter of law. Id.; see also In re Lee, 277 F.3d 1338, 1344 (Fed. Cir. 2002) ("[i]t is improper, in determining whether a person of ordinary skill would have been led to a combination of references, simply to use that which the inventor taught against its teacher"). Thus, applicants respectfully submit that their own disclosure has been impermissibly relied on in hindsight to see a suggestion in Uranaka that simply is not present.

Therefore, for at least the foregoing reasons, applicants submit that independent claims 1, 32, 35, 36, 37, 40 and 41 are allowable over the prior art of record. Claims 2-31, 33-34, 38-39, and 41-71, which include all the limitations of their respective base claims, are allowable for at least the same reasons.

V. Conclusion

For the reasons set forth above, claims 1-71 are allowable over the prior art of record. This application is therefore in condition for allowance. Reconsideration and allowance are accordingly respectfully requested.

Respectfully submitted,



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